

REMARKS - DOUBLE PATENTING REJECTION

Claims 9-27 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 8-20 of U.S. Patent No. 6,122,060 in view of Iuchi, et al. (US 4,619,529). The Examiner states:

Claims 9-27 are already protected by claims 8-20 of U.S. Patent No. 6,122,060 in that claims 9-27 of the present application is broader in scope than the claims of U.S. Patent No. 6,122,060 in that claims 9-27 now has less limitations and although the wording may not be duplicated, limitations are already protected. Therefore, the infringement of the claims of U.S. Patent No. 6,122,060 would also infringe the claims of the present application. Furthermore, with regards to applicant's remarks that the phase modulated light results from scattering incident light from ultrasonic displacement, claims 1, 8, and 15 of U.S. Patent No. 6,122,060 recite that the phase modulated light results from scattering incident light from ultrasonic displacement. With regards to claims 24 and 27, U.S. Patent No. 6,122,060 does not claim the use of a transducer to produce the ultrasonic surface displacements but discloses that transducers and other means are known in the art. In addition, Iuchi et al teaches other forms of producing ultrasonic surface displacements and in particular, the use of a transducer. At the time of the invention, it would be obvious to one of ordinary skill in the art that other functionally equivalent means for producing ultrasonic displacement can be used as taught by Iuchi et al, and in particular, one of ordinary skill in the art would have used a transducer for its lower cost as is generally known in the art that transducers cost less than lasers. The claims correspond as follows:

Pending Claims Patented Claim of US 6,122.060

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22	8
23	8
24	8+Iuchi et al
25	8
26	15
27	15+Iuchi et al

Claims 9 - 21 stand rejected under the statutory prohibition against double patenting under 35 USC §101, in view of prior U.S. Patent No. 6,122,060. 35 USC § 101 prevents two patents from issuing on the same invention. "Same invention" is taken to mean identical subject matter. *In re Vogel* teaches that the test for same invention double patenting is whether one of the claims of one patent could be literally infringed without literally infringing one of the claims in the other patent.

Applicant respectfully traverses the examiners assertion that the present invention as claimed be rejected under the statutory prohibition against double patenting under 35 USC §101, in view of prior U.S. Patent No. 6,122,060. However, in addition to the remarks traversing the

examiner's assertion as provided below, applicant respectfully submits the attached terminal disclaimer in compliance with 37 CFR 1.321(c) to overcome an actual or provisional rejection based on nonstatutory double patenting.

Applicant respectfully submits that Claims 9 and 6 have been amended such that it is possible to not infringe the claims of U.S. Patent No. 6,122,060 and still infringe the amended claims 9 and 16 of the instant application. As the present invention focuses on the post-collection optical amplification of the phase modulated light, wherein the phase modulated light results from scattering incident light with ultrasonic displacements. These ultrasonic displacements may be generated through a number of known methods. Thus, amended Claim 9 does not include the limitation of: "using a first pulsed laser beam to generate the ultrasonic surface displacements at the target;" Therefore an apparatus or method that did not utilize a first pulsed laser beam to generate the ultrasonic surface displacements at the target could infringe amended Claim 9 but not the similar method Claims of U.S. Patent No. 6,122,060 which require a first pulsed laser beam to generate the ultrasonic surface displacements at the target. Other means may be utilized to generate the ultrasonic surface displacements at the target. One such example is a transducer operably coupled to the surface of the target. This element is specifically claimed in new claim 24 to illustrate this difference.

Additionally, the requirement of an optical isolation assembly to prevent feedback in the optical amplifier has been removed from amended independent claim 9. Therefore, the instant application could be infringed by a system lacking the optical isolation assembly that prevents feedback into the optical amplifier that the claims of U.S. Patent No. 6,122,060 require. This is further clarified by new Claim 25 which depends from Claim 9. Claim 25 provides the method of Claim 9 that further includes the prevention of optical feedback within the optical amplifier from phase-modulated light.

Similarly, Claim 16 has also been amended to remove the requirement of at least one optical isolation assembly within the path of the phase-modulated light. Therefore, the instant application could be infringed by a system lacking the optical isolation assembly that prevents feedback into the optical amplifier that the claims of U.S. Patent No. 6,122,060 require.

Applicant respectfully submits that Claims 9 - 25 as presented differ from those claims contained within U.S. Patent No. 6,122,060. Specifically, the instant claims could be literally infringed without literally infringing the claims of U.S. Patent No. 6,122,060. As the instant

application and U.S. Patent No. 6,122,060 currently fail to claim the same invention twice, Applicant respectfully requests that the rejection of statutory double patenting under 35 USC §101 be withdrawn.

CONCLUSION

Applicant appreciates the time taken by the Examiner to review Applicant's present application. This application has been carefully reviewed in light of the Official Action mailed November 26, 2004. Applicant respectfully requests reconsideration and favorable action in this case.

Applicant has now made an earnest attempt to place this case in condition for allowance. For the foregoing reasons and for other reasons clearly apparent, Applicant respectfully requests full allowance of Claims 9-27.

While Applicants believe no fee is due with this transmission, if any fees are due, the Commissioner is hereby authorized to charge Deposit Account No. 50-2240 of Koestner Bertani.

Respectfully submitted,

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